

REMARKS/ARGUMENTS

Preliminarily, Applicants thank the Examiner for indicating the allowability of claims 5, 6 and 7. Reconsideration and allowance of the present application based on the following remarks are respectfully requested. Claims 1, 9 and 10 have been amended. Claims 5-7 have been cancelled and rewritten as new claims 11, 13 and 14. New Claims 11-16 have been added. Support for the amendments and the new claims may be found throughout the specification. No new matter has been added. Upon entry of the above amendments, claims 1-4 and 8-16, as amended, will be pending.

Claims 1, 5, 9 and 10 have been rejected under 35 U.S.C. § 112, second paragraph as indefinite. The amendments to the claims are believed to place them in full compliance with 35 U.S.C. § 112. Applicants respectfully request reconsideration and withdrawal of these rejections.

Claims 1-4 and 8-10 have been rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent 6,653,398 to Hazen, *et al.* ("Hazen"), EP 287 306 to Minnesota Mining and Manufacturing Company ("3M") or WO 92/01750 to EKA Nobel AB ("Nobel"), in view of U.S. Patent 3,004,056 to Nunn, Jr., *et al.* ("Nunn"). With respect to these rejections, Applicants submit the Examiner has failed to establish a *prima facie* case of obviousness. Specifically, none of the cited references suggest a resin composition that includes a polyoxyalkylene group terminating in a branched group according to the present invention. The resins discussed in Hazen and 3M do not suggest a polyoxyalkylene terminating in a branched group. The esters of Nobel also do not include branched alkyl groups and are pre-reacted with a base resulting in a composition that is different from the present invention. Finally, Nunn does not suggest a resin composition at all or that a surfactant is useful in a resin composition. As Hazen and 3M prefer the use of alkylaryl groups and do not teach or suggest using branched alkyl groups, the combination of the references does not teach or suggest using branched alkyl groups containing surfactants in resin compositions to one of ordinary skill in the art.

The Examiner appears to be using hindsight to reconstruct Applicants' invention from prior art with no proper motivation provided for combining the references. The Federal Circuit has made it clear that obviousness cannot be

established simply by stitching together pieces of prior art using the patent as a template. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143 (Fed. Cir. 1985); see also Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 873 (Fed. Cir. 1985) (denouncing courts' tendency to depart from proper standard of nonobviousness "to the tempting but forbidden zone of hindsight."); In re Fine, 837 F.2d 1071, 1075 (Fed. Cir. 1988) ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."); In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."). Respectfully, it is an incorrect application of the law for the Examiner in this case to pick and choose different parts of the cited references to construct Applicant's invention to render it obvious. The courts have uniformly found this approach to obviousness rejections to be incorrect. Each of the cited references must provide some suggestion, motivation, or teaching for combining known components. See Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc., 21 F.3d 1068, 1072, 30 USPQ2d 1377, 1379 (Fed.Cir.1994) ("When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination."); C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340 (Fed. Cir. 2000). There has been no proper motivation provided in this case. The Examiner attempts to find a motivation among the general language of Dunn, but this language fails to provide the specific motivation to combine the references required. As a result, the Examiner has failed to provide a proper *prima facie* case of obviousness.

Accordingly, Applicants respectfully request reconsideration and withdrawal of these rejections.

Therefore, all objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly solicited.

Should any issues remain unresolved, the Examiner is encouraged to contact the undersigned attorney for Applicants at the telephone number indicated below in order to expeditiously resolve any remaining issues.

Respectfully submitted,

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